

DOCKET NO.: MSFT-0556 / 140707.01
Application No.: 09/717,680
Office Action Dated: April 21, 2004

PATENT

REMARKS/ARGUMENTS

Overview of the Office Action

Claims 1, 2, 8-10, 15-20, and 22-27 were rejected under 35 U.S.C. § 102(e) as being anticipated by Charisius et al. (U.S. Patent Application Publication No. US 2002/0016954).

Claims 3-7, 21, and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Charisius in view of Washburn et al. (U.S. Patent No. 5,157,779).

Claims 11-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Charisius in view of Williamson et al. (U.S. Patent No. 6,122,641) in further view of Peddada et al. (U.S. Patent No. 6,031,533).

Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Charisius in view of Gupta et al. (U.S. Patent No. 6,484,156).

Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Charisius in view of Gupta et al. (U.S. Patent No. 6,484,156) and O'Donnell et al. (U.S. Patent No. 6,223,203).

Status of the Claims/Amendments

Claims 1-28 are pending.

Claims Rejected Under 35 U.S.C. § 102(e)

Claims 1, 2, 8-10, 15-20, and 22-27 were rejected under 35 U.S.C. § 102(e) as being anticipated by Charisius et al. (U.S. Patent Application Publication No. US 2002/0016954). In

response, however, Applicants respectfully submit that the Examiner has not made a *prima facie* case that the Charisius reference constitutes proper anticipating art under 35 U.S.C. § 102(e) and, therefore, the rejections are invalid.

Without conceding the validity of any aspects of the Examiner's rejection, Applicants respectfully submit that the filing date of the present Application (November 21, 2000)—which is also the *de facto* inventive date for the invention of the present Application—predates the filing date of the Charisius referenced (April 20, 2001). Therefore, absent any priority claim, the Charisius reference would not constitute prior art under 35 U.S.C. § 102(e), and thus the extent to which Charisius may in fact constitute prior art is limited to (a) whether it's claim of priority to an earlier filed application which predate the filing date of the present Application is indeed valid as to the entire Charisius reference and (b) whether each and every element of the rejected claims is taught by one or more earlier filed applications to which Charisius claims priority and which predate the filing date of the present Application.

In regard to the first criteria—that the claim of priority to an earlier filed application which predates the filing date of the present Application as to the entire Charisius reference is indeed valid—a *prima facie* showing of anticipation requires that all of the elements of at least one claim in the Charisius reference must be found and enabled in one of the earlier filed applications to which Charisius claims priority (and which has an earlier filing date that predates the filing date of the present Application). With regard to claiming priority to a provisional application (e.g., the Charisius claim of priority to provisional application No. 60/199,046), 35 USC § 119(e)(1) states the following:

35 U.S.C. 119. Benefit of earlier filing date; right of priority.

...

(e)(1) An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title...

With regard to claiming priority to a non-provisional application (e.g., the Charisius claim of priority to non-provisional application No. 09/680,063, which in turn claims priority to provisional application No. 60/199,046), 35 USC § 119(e)(1) states the following:

35 U.S.C. 120. Benefit of earlier filing date in the United States.

An application for patent for an invention **disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed** in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

(emphasis added). Also, in regard to both 35 USC § 119(e) and 35 USC § 120, MPEP § 201.11 further states the following:

(A) The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); **the disclosure of the invention in the prior application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112.** See *Transco Prods., Inc. v.*

Performance Contracting, Inc., 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994). See subsection I. "WRITTEN DESCRIPTION" below.

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I. WRITTEN DESCRIPTION

Under 35 U.S.C. 120, a claim in a U.S. application is entitled to the benefit of the filing date of an earlier filed U.S. application if the subject matter of the claim is disclosed in the manner provided by 35 U.S.C. 112, first paragraph, in the earlier filed application. See, e.g., Tronzo v. Biomet, Inc., 156 F.3d 1154, 47 USPQ2d 1829 (Fed. Cir. 1998); In re Scheiber, 587 F.2d 59, 199 USPQ 782 (CCPA 1978). A claim in a subsequently filed application that relies on a combination of prior applications may not be entitled to the benefit of an earlier filing date under 35 U.S.C. 120 since 35 U.S.C. 120 requires that the earlier filed application contain a disclosure which complies with 35 U.S.C. 112, first paragraph for each claim in the subsequently filed application. Studiengesellschaft Kohle m.b.H. v. Shell Oil Co., 112 F.3d 1561, 1564, 42 USPQ2d 1674, 1677 (Fed. Cir. 1997).

Under 35 U.S.C. 119(e), the written description and drawing(s) (if any) of the provisional application must adequately support and enable the subject matter claimed in the nonprovisional application that claims the benefit of the provisional application. In New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co., 298 F.3d 1290, 1294, 63 USPQ2d 1843, 1846 (Fed. Cir. 2002), the court held that for a nonprovisional application to be afforded the priority date of the provisional application, "the specification of the provisional must 'contain a written description of the invention and the manner and process of making and using it, in such full, clear, concise, and exact terms,' 35 U.S.C. § 112 1, to enable an ordinarily skilled artisan to practice the invention claimed in the nonprovisional application."

(emphasis added). Therefore, based on the foregoing analysis, a *prima facie* showing of anticipation requires that each and every element of at least one claim in the Charisius reference

must be found and enabled in one of the earlier filed applications to which Charisius claims priority (and which has a filing date that predate the filing date of the present Application).

In regard to the second criteria—that each and every element of the rejected claims is taught by an earlier filed application to which Charisius claims priority and which predates the filing date of the present Application—a *prima facie* showing of anticipation requires that each and every element for each rejected claim be found and enabled in one of the earlier filed applications to which Charisius claims priority (and which has a filing date that predates the filing date of the present Application). For the same reasons (and relying upon the same support) provided in the analysis of the first criteria earlier herein, the necessity for showing that each and every element of each claim rejected by the Examiner is in fact found in an earlier filed application to which Charisius claims priority and which predates the filing date of the present Application is necessary in order to establish the priority date of each such element.

In summary, the rejection of Claims 1, 2, 8-10, 15-20, and 22-27 under 35 U.S.C. § 102(e) as being anticipated by Charisius et al. (U.S. Patent Application Publication No. US 2002/0016954) where the filing date of the present Application predates the filing date of the Charisius reference constitutes a *de facto* rejection of these claims by the references to which the Charisius reference claims priority. **However, no *prima facie* showing has been made to demonstrate that the claim of priority in Charisius to any of these earlier filed applications with filing dates that predate the filing date of the present Application are indeed valid as to the entire Charisius reference, nor has there been any *prima facie* showing that each and every element of any of the rejected claims is in fact taught by one of these earlier filed**

applications to which Charisius claims priority and which predate the filing date of the present Application, and thus the rejections are not valid. Therefore, Applicants respectfully submit that the Examiner has not made a prima facie case that the Charisius reference constitutes proper anticipating art under 35 U.S.C. § 102(e), and Applicants respectfully request that the Examiner show a prima facie case for a rejection of these claims in regard to both criteria discussed herein—that the claim of priority in Charisius to the earlier filed applications with filing dates that predate the filing date of the present Application are indeed valid as to the entire Charisius reference, and that each and every element of each and every rejected claim is in fact taught by one of these earlier filed applications to which Charisius claims priority and which predate the filing date of the present Application—and Applicants also request that the Examiner provide the Applicants with copies of these priority references; or, alternately, withdraw the rejections in their entirety and that Claims 1, 2, 8-10, 15-20, and 22-27 be allowed to issue.

Claims Rejected Under 35 U.S.C. § 103(a)

Claims 3-7, 21, and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Charisius in view of Washburn et al. (U.S. Patent No. 5,157,779). Claims 11-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Charisius in view of Williamson et al. (U.S. Patent No. 6,122,641) in further view of Peddada et al. (U.S. Patent No. 6,031,533). Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Charisius in view of Gupta et al. (U.S. Patent No. 6,484,156). Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Charisius in view of Gupta et al. (U.S. Patent No. 6,484,156) and O'Donnell et

al. (U.S. Patent No. 6,223,203). In summary, Claims 3-7, 11-14, 21, and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Charisius as the primary reference in view of an additional secondary supporting references.

In response, and without conceding the validity of any aspects of the Examiner's rejection, Applicants respectfully submit that a *prima facie* case for the rejection of Claims 3-7, 11-14, 21, and 28 under 35 U.S.C. § 103 has not been made for the same reasons discussed herein above in regard to the 35 U.S.C. § 102(e) rejections as to the Charisius reference and, therefore, the rejections herein under 35 U.S.C. § 103 are likewise invalid. Therefore, Applicants respectfully request that the Examiner show a *prima facie* case for a rejection of these claims in regard to both criteria discussed herein—that the claim of priority in Charisius to the earlier filed applications with filing dates that predate the filing date of the present Application are indeed valid as to the entire Charisius reference, and that each and every element of each and every rejected claim for which Charisius is cited is in fact taught by one of these earlier filed applications to which Charisius claims priority and which predate the filing date of the present Application—and Applicants also request that the Examiner provide the Applicants with copies of these priority references; or, alternately, withdraw the rejections in their entirety and allow Claims 3-7, 11-14, 21, and 28 to issue.

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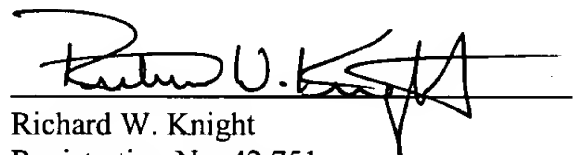
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CONCLUSION

Based on the reasons and rationale set forth herein, Applicants respectfully submit that, given the absence of a prima facie showing of anticipation and/or obviousness in the Office Action, the objections and rejections are invalid and, accordingly, Applicants request that the objections and rejections be withdrawn and that the claims be allowed to issue. Should the Examiner have any questions, comments, or suggestions that would expedite the prosecution of the present case to allowance, Applicants' undersigned representative earnestly requests a telephone conference at (206) 332-1394.

Respectfully submitted,

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Richard W. Knight
Registration No. 42,751

Woodcock Washburn LLP
One Liberty Place - 46th Floor
Philadelphia PA 19103
Telephone: (215) 568-3100
Facsimile: (215) 568-3439